

REMARKS

Claims 1-3 and 5-23 are pending in the application. In an Advisory Action mailed on August 29, 2005, claims 1-3, 5-10, and 12-23 were deemed to be allowed, with claim 11 being the only remaining claim subject to rejection. In the interest of expediting prosecution, and as is noted above, claim 11 has now been canceled, without prejudice. Applicants thus respectfully request a Notice of Allowance for claims 1-3, 5-10, and 12-23.

Applicants further request consideration of an Information Disclosure Statement filed today, and submit that this Information Disclosure Statement should be entered, because the finality of the prior Office Action was in error.

In particular, as was stated in a Reply filed on July 25, 2005, the prior Office Action was made final, with the Examiner stating that Applicants' amendments necessitated the present rejection under § 112, first paragraph. Applicants respectfully submit that this was not the case and, thus, again request that the finality of the Office Action be withdrawn. In particular, Applicants submit that the subject matter upon which the rejection under § 112, first paragraph is based, relating to the use of mono-hydroxylated amino acids other than 4-hydroxyisoleucine and poly-hydroxylated amino acids in connection with inducing insulin-sensitizing or insulin-mimetic effects, was present in the claims as filed. Thus, if the Examiner had wanted to reject the claims due to this subject matter, then this rejection should have been made in the first Office Action. Other than claim 14, the claims were not examined on their merits in the first Office Action, on the basis that claims 1-13 were found to be drawn to non-statutory subject matter. However, such a finding does not support examination that lacks consideration of the other statutory requirements for patentability. This is made clear, for example, in M.P.E.P. § 2105,

which discusses the approach to be used when examining a claim to non-statutory subject matter (in this example, naturally occurring, living subject matter):

If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. Furthermore, the claimed invention must be examined with regard to all issues pertinent to patentability, and any applicable rejections under 35 U.S.C. 102, 103, or 112 must also be made.

There is no reason to believe that this standard does not apply to other types of non-statutory subject matter. Thus, it is clear that, regardless of whether a claim is drawn to statutory subject matter, examination with respect to other statutory requirements must take place. In the present application, therefore, Applicants' amendment did not necessitate the rejection under § 112, first paragraph, and the finality of this Office Action should therefore be withdrawn.

In view of the above, Applicants submit that the Information Disclosure Statement should be considered and request that an initialed Form PTO 1449 be returned as soon as possible. In any event, the Information Disclosure Statement and references should be placed in the file.

CONCLUSION

Applicants submit that the claims are in condition for allowance, and such action is respectfully requested. If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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